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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

Ex parte SARJIT JOHAL

Appeal 2012-008650
Application 12/499,205
Technology Center 1700

Before CHUNG K. PAK, KAREN M. HASTINGS, and
JAMES C. HOUSEL, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-26 as obvious under 35 U.S.C. § 103(a) over Johal (US 2005/0100881 A1, published May 12, 2005). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

Claim 1 is illustrative of the claimed subject matter:

1. A method comprising:

providing a plurality of cells; and

subjecting said cells to heat, pH, and shear under conditions sufficient to rupture the walls of at least some of said plurality of cells to allow cytoplasm to be released therefrom thereby forming a mixture of ghosts and cytoplasm, said cells being cooked in a jet-cooking apparatus and being subjected to mechanical shear in a homogenizer.

Appellant argues the claims as a group, and does not present any separate arguments for any specific claim (App. Br. 6-10). Accordingly, we select claim 1 as representative.

ANALYSIS

Upon consideration of the evidence on this record and each of Appellant's contentions, we find that the preponderance of evidence on this record supports the Examiner's conclusion that the subject matter of Appellant's claims is unpatentable over the applied prior art. We sustain the above rejections based on the Examiner's findings of fact, conclusions of law, and rebuttals to Appellant's arguments as expressed in the Answer.

We add the following for emphasis.

There is no dispute that Johal discloses subjecting the cells "to heat, pH, and shear under conditions sufficient to rupture the walls of at least some of said plurality of cells to allow cytoplasm to be released therefrom thereby forming a mixture of ghosts and cytoplasm, said cells being cooked in a jet-cooking apparatus" as recited in claim 1. Johal only fails to explicitly state that the "cells are subjected to mechanical shear in a homogenizer" in combination with the jet-cooking step.

Appellant's argument that Johal teaches away from using mechanical shear (App. Br. 6-8) is unavailing for the reasons aptly pointed out by the Examiner (Ans. 11, 12). *See, In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005) (whether a reference teaches away from a claimed invention is a question of fact); *see also Syntex (U.S.A.) LLC v. Apotex, Inc.* 407 F.3d 1371, 1380 (Fed. Cir. 2005); *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (a known or obvious device or method "does not become patentable simply because it has been described as somewhat inferior to some other device [or method] for the same use.").¹

Appellant's argument that Johal does not explicitly teach that mechanical methods are interchangeable or combinable with other forms of rupturing cell walls (App. Br. 9, 10) is unavailing for the reasons explained by the Examiner (e.g., Ans. 13, 14). A preponderance of the evidence supports the Examiner's determination that even though paragraph [0028] of Johal does not explicitly state combining mechanical methods with the jet-cooking step, such a combination of steps "would nonetheless be obvious to a skilled practitioner in light of the disclosure in paragraph [0005] regarding the utility of mechanical methods for rupturing cells" (Ans. 14). Furthermore, in light of Appellant's Specification, the mechanical shearing step in a homogenizer as required in claim 1 need not result in a mixture any more homogenous than the entering mixture of cells (Spec. para. [19]).

¹ It is also well established that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

It is well established that ordinary creativity is presumed on the part of one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.”). A preponderance of the evidence supports the Examiner’s determination that, one of ordinary skill in the art, using no more than ordinary creativity, would have found it obvious to use mechanical shear in a homogenizer (as recited in claim 1), as exemplified in the admitted prior art discussed in Johal for rupturing cells (Johal, e.g. para [0005]), in addition to the jet-cooking of Johal, for the known benefits of mechanical methods of rupturing (e.g., Ans. 5). *See KSR*, 550 U.S. at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). The analysis need not seek out precise teachings directed to the specific subject matter of the claim, for it is proper to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 418. Furthermore, the idea of combining known steps of mechanical rupture and jet-cooking also flows logically from their having been individually taught in the prior art. *Cf. In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980).

The Examiner’s decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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